

REMARKS

All the claims presently in this application have been made subject to a restriction requirement wherein the Official Action submits that the thirty-nine claims of the present application are directed to three distinct and independent inventions. The three inventions alleged to be included in the forty claims of the present application are as follows:

- I. Claims 1-8, and 39 drawn to compound of formula (I).
- II. Claims 9-17 drawn to a pharmaceutical composition containing active ingredient of Group I and an additional physiologically active ingredient.
- III. Claims 34-38, drawn to process of making compounds.

In response to the above-described restriction requirement, applicants have provisionally elected, with traverse, Group I, drawn to compound of formula (I), which is encompassed by Claims 1-8 and 39, for prosecution on the merits in this application. Applicants hereby reserve their right to file a divisional application(s) directed to the non-elected subject matter in this application.

Furthermore, pursuant to 37 C.F.R. §§1.111 & 1.143, Applicants hereby traverse the Examiner's requirement for restriction and request reconsideration thereof for the following reasons.

A requirement for restriction presupposes an analysis of the subject application in light of the rules governing the practice, i.e., 37 C.F.R. §1.499 and PCT Rule 13.1 and 13.2. PCT Rule 13.1, first sentence, states: "The international application shall relate to one invention only as to a group of inventions so linked as to form a single general inventive concept ('requirement of unity of invention')." (Emphasis added). PCT Rule 13.2 states: The expression "technical feature" shall mean those technical features that define a contribution

which each of the claimed inventions, considered as a whole, makes over the prior art.

(Emphasis added).

In the Official Action, the Examiner contends that Groups I, II and III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical feature.

In response, applicants submit that Groups I, II and III are linked by a special technical feature as to form a single general inventive concept. Specifically, Group I is directed to a compound of formula (I), Group II is drawn to a pharmaceutical composition comprising the compound of formula (I), and Group III is directed to a process of preparing the compound of formula (I). Therefore, Groups I, II and III are interrelated and interdependent, and thus they are linked by a special technical feature as to form a single general inventive concept. Accordingly, consistent with 37 C.F.R. §1.475(b), applicants respectfully request that the United States Patent and Trademark Office should consider withdrawing the imposed restriction requirement and examining all claims in the instant application.

As to the citation to ES 2142773, applicants respectfully submit that unity of invention, not novelty, is the issue at hand. Applicants should be given the opportunity to argue the merits during prosecution, i.e. whether the claims are novel over the prior art. Restriction of the claims at the stage would deny applicants such an opportunity.

In view of the foregoing comments, it is respectfully urged that the Examiner withdraw the requirement for restriction and provide an action on the merits with respect to all of the claims.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Mark J. Cohen". The signature is fluid and cursive, with the first letters of the first and last names being capitalized and prominent.

Mark J. Cohen

Registration No. 32,211

Scully, Scott, Murphy & Presser, P.C.
400 Garden City Plaza, Suite 300
Garden City, New York 11530
(516) 742-4343
AZ/MJC:dg